

Docket No.: 4590-418

JAN 18 2007

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Denny WERNHAM *et al.*

U.S. Patent Application No. 10/539,623

Filed: June 17, 2005

For: AN OPTICAL FILTER

: Confirmation No. 2905

: Group Art Unit: n/a

: Examiner: n/a

RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)

## Mail Stop PCT

Commissioner for Patents, Office of PCT Legal Administration

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This is in response to a Decision dated December 1, 2006. In the Decision, it was stated that items (1), (3) and (4) were satisfied, but item (2) of 37 CFR 1.47 (a) was not satisfied – factual proof that the non-signing inventor was provided with the copies of the application papers and explanation of the e-mail correspondence where the inventor refuses to execute the application. Applicants submit herewith a copy of a letter dated September 21, 2005 which indicates that application papers including: specification, claims, abstract and drawings were mailed to Denny Wernham together with Declaration and Assignment forms.

Also, Applicants submit a copy of e-mail correspondence between inventor Denny Wernham and contracts manager Ian D. Morgan of Thales Optics Limited. In the attached e-mail copy dated September 28, 2005, inventor Denny Wernham acknowledges receipt of the above documents. Further, in October 6, 2005 e-mail Denny Wernham stated that he refuses to sign the required documents. Accordingly, an item (2) has now been satisfied because the inventor acknowledged receipt of the application papers and refused to sign same.

CERTIFICATION OF FACSIMILE TRANSMISSION  
I HEREBY CERTIFY THAT THIS PAPER IS BEING FACSIMI-  
LE TRANSMITTED TO THE PATENT AND TRADEMARK OFFICE  
ON THE DATE SHOWN BELOW

TYPE OR PRINT NAME OF PERSON SIGNING CERTIFICATION

SIGNATURE

DATE

571-273-8300

U.S. Patent Application No. 10/539,623

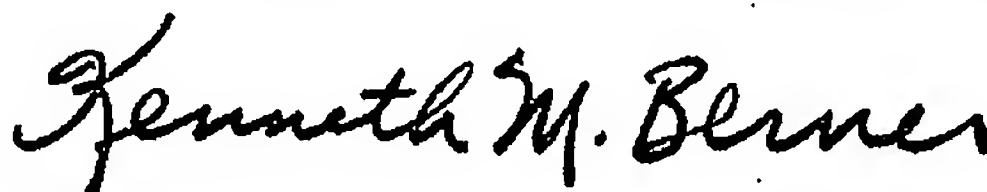
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Based on the above, all outstanding requirements of 37 C.F.R. 1.47 (a) having been satisfied, a favorable decision on the above petition is hereby requested.

No additional petition fee is required. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

LOWE HAUPTMAN & BERNER, LLP



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Your ref

Our ref Leg.01.USpatent

Date 21<sup>st</sup> September 2005

Direct Line 01745 588073

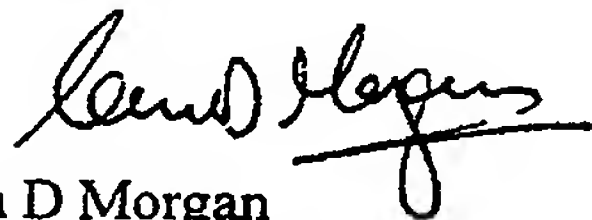
Dear Mr Wernham

**US Patent Application - Declaration Power and Assignment**

Please find enclosed application papers including: specification, claims, abstract and drawings as filed in the United States Patent and Trademark Office (USPTO) on 17<sup>th</sup> June 2005. Further, we herein provide copies of a Declaration, power and Assignment regarding the above-identified application for your signature. As one of the inventor(s) for the above application, USPTO requires us to provide a signed Declaration as part of the above-identified patent application. Please kindly sign the enclosed forms and forward to us as soon as possible.

Should you wish to discuss anything in respect of the above request please feel free to speak with the undersigned.

Yours sincerely



Ian D Morgan

**Contracts Manager - Thales Optics Limited**

FM 29714



INVESTOR IN PEOPLE

Thales Optics Ltd  
Registered Office Glascoed Road, St. Asaph, Denbighshire LL17 0LL  
Registered in England Company Number 876004

Subject: RE: Leg.01.USpatent

De: "Fleming, David" <David.Fleming@uk.thalesgroup.com>

Date: Mon, 21 Nov 2005 14:50:20 -0000

Pour: "danielle.thivel@fr.marks-clerk.com" <danielle.thivel@fr.marks-clerk.com>

Danielle,

Here is the email referred to in my earlier email. Please let me know if you need anything else.

David

-----Original Message-----

From: Denny.Wernham@esa.int [mailto:Denny.Wernham@esa.int]

Sent: 06 October 2005 15:58

To: Morgan, Ian

Subject: RE: Leg.01.USpatent

Ian,

The reply is at the moment no. Furthermore, I have no intention of signing my rights to it (or indeed representing you in court over the same due to past history of doing this in the past and being compensated with absolutely nothing but pain and misery). In addition, I believe that you have potentially gained millions of pounds in sales already from this patented item with no compensation to any of the patentees.

The contractual situation is messy but appears that I have no obligations whatsoever to sign over this patent. My legal advise certainly suggests this. Please transmit this to David - he is (or has been) aware of my position. Maybe he can persuade the company (now that you are owned by venture capitalists) to invest in its employees.

without prejudice

Denny Wernham

"Morgan, Ian" <Ian.Morgan@uk.thalesgroup.com>

06/10/2005 15:51

To: "Denny.Wernham@esa.int" <Denny.Wernham@esa.int>

cc:

Subject: RE: Leg.01.USpatent

Denny,

Apologies for you appearing to harass you on this, but have you signed and returned the documents I sent to you yet? David Fleming is in and out of the office at the moment (he's not in for most of next week) and has asked me to progress this.

Thanks

Ian

-----Original Message-----

From: Denny.Wernham@esa.int [mailto:Denny.Wernham@esa.int]

Sent: 29 September 2005 12:23

To: Morgan, Ian

Subject: RE: Leg.01.USpatent

Thanks for clarification Ian. I will contact David upon his return.

regards,

Denny

"Morgan, Ian" <Ian.Morgan@uk.thesgroup.com>

28/09/2005 16:23

To: "Denny.Wernham@esa.int" <Denny.Wernham@esa.int>  
cc: "Fleming, David" <David.Fleming@uk.thesgroup.com>  
Subject: RE: Leg.01.USpatent

Dear Denny,

I merely sent the documents to you in David Fleming absence, David remains your POC in this matter.

Regards

Ian

-----Original Message-----

**From:** Denny.Wernham@esa.int [mailto:Denny.Wernham@esa.int]

**Sent:** 28 September 2005 11:02

**To:** ian.morgan@uk.thesgroup.com

**Subject:** Leg.01.USpatent

Dear Ian,

hope things are well over in sunny St. Asaph. Could you confirm that it is yourself who I should correspond with regarding the above (which I received yesterday). There is some history to this. I can explain position once you confirm.

Thanks

Denny

Denny Wernham

TEC-QMC

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